

**REMARKS**

**Improper Final Rejection**

Applicant appreciates the examiner's withdrawal of the prior Final Office Action mailed on 25 June 2007, but is disappointed that the next action issued by the examiner after that withdrawal of final rejection is also made final. Indeed, it appears that making this current Office Action final is improper, or is at least counter to examination guidelines.

Specifically, the examiner states that Applicant's amendment necessitated the new grounds of rejection, but that statement is inaccurate. Applicant amended claims in response to the non-final Office Action of 19 Dec. 2006. In response to those amendments, the examiner issued a final Office Action on 25 June 2007. The final rejections in that Office Action were unrelated to the previous non-final rejections and were based on newly cited art. The newly cited art was unrelated to Applicant's claims (either before or after entry of the submitted amendments). As Applicant's undersigned attorney explained in a post-final telephone interview and in a subsequent after-final response, June's final rejection was deeply flawed and would not survive scrutiny on appeal. Applicant's after-final response made no claim amendments and essentially did no more than point out that the cited reference plainly did not teach what the examiner alleged.

Put simply, Applicant's claim amendments of two office actions ago cannot be argued as necessitating these new grounds of rejection and the previous Final Office Action did not advance prosecution on the merits because, respectfully, the reference used to make that Final Rejection was irrelevant to Applicant's claimed invention. Therefore, Applicant's arguments pointing out the many missing teachings in that reference cannot be argued as necessitating a new final rejection.

Section 706 of the MPEP states, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide

evidence of patentability and otherwise reply completely at the earliest opportunity." Applicant submits that the reference used in this second final rejection should have been presented by the examiner earlier in the prosecution process, so that Applicant was presented with an opportunity to reply with counterevidence of patentability. On that point, 37 C.F.R. § 1.104(2) states, "[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command." (Emphasis added.) Applicant submits that the new reference was available to the examiner and should have been cited properly in a non-final action.

Reinforcing the directive that an applicant be given a fair opportunity to respond to rejection arguments, Section 706.07 of the MPEP states in part, "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant." (Emphasis added.) In this case, the examiner has given Applicant no opportunity to develop a clear issue. That same section of the MPEP also states, "[t]o bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied...." Applicant respectfully submits that the examiner's initial and/or subsequent search effort should have identified the new reference. (That point is particularly meaningful in light of the inapplicability of the prior final rejection reference.)

Section 706.07 of the MPEP also states, "[s]witching ... from one set of references to another by the examiner in rejecting successive actions claims of substantially the same subject matter will [alike] tend to defeat attaining the goal of reaching a clearly defined issue for an early termination...." In the instant prosecution, Applicant amended claims in response to a non-final rejection. In response, the examiner dropped the non-final rejections, and issued entirely new final rejections, subsequently withdrew all such final rejections, and then found an entirely new reference and issued entirely new final rejections. No action by Applicant necessitated this

behavior, and even a quick examination of the record reveals ever shifting rejection arguments by the examiner.

Applicant is being asked to hit a moving target, based on constantly shifting references. Worse, the examiner has moved the target yet again and now denies Applicant a fair opportunity to respond. As Section 706.07 of the MPEP further states, "[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." Applicant is not asking for more than is fairly deserved, but rather is asking simply for the opportunity to respond to new grounds of rejection that cannot be argued as being necessitated by Applicant.

Applicant will present the above arguments on appeal, should the examiner persist in maintaining the finality of this rejection, and believes that the prosecution record makes clear that the current final rejection does not comport with the Office's practice goals and should be withdrawn. Of course, Applicant will also present substantive arguments rebutting the outstanding final rejections as legally insufficient. Such arguments appear in detailed form below.

*The 102 Rejections are Improper*

Claims 1, 6, 8-10, 13, 15-17, 19, 20, 22, 23, 27, and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,307,845 to Hummelgren, et al. ("Hummelgren"). Independent claim 1, for example, is presented as:

1. A method of call handling in a wireless communication network comprising:  
receiving an incoming voice call for a mobile station that is busy in a packet-switched data call;  
sending an incoming call notification to the mobile station via signaling over an existing traffic channel allocated to the data call; and  
reconfiguring the existing traffic channel to support the incoming voice call and delivering the incoming voice call to the mobile station via the reconfigured existing traffic channel.

Hummelgren does not teach receiving an incoming voice call for a mobile station that is busy in a packet-switched data call, and therefore fails as an anticipating reference. (The examiner is reminded that a reference anticipates only if it teaches every limitation of the claim at issue, in the identical arrangement as claimed.) Hummelgren teachings regarding call processing for a busy mobile station are, in fact, addressed to the opposite condition, i.e., where a mobile station is busy in a circuit-switched call when a packet-switched call comes in.

For example, Item 4 of the Final Office Action states that Hummelgren within the meaning of claim 1 teaches "receiving an incoming voice call for a mobile station that is busy in a packet-switched data call...." In support, the examiner refers to Hummelgren at the Abstract, Fig. 3, elements 30 and 32, col. 2, lines 30-42, Fig. 4, steps 21 and 23 and the corresponding specification description.

Hummelgren's Abstract expressly contradicts the examiner by plainly discussing a mobile station busy scenario where the mobile station is described as being busy in a "circuit-switched voice call" when a "packet-switched voice call" comes in. That clear language makes plain that the examiner and Applicant are not disagreeing over claim construction issues; rather, Hummelgren explicitly teaches the case where a packet-switched call is received for a mobile station already busy in a circuit-switched voice call. In direct contrast, the context of claim 1 is explicitly and unambiguously stated as the opposite case where a (circuit-switched) voice call is received for a mobile station busy in a packet-switched data call.

Hummelgren when taken in its entirety, and when taken selectively at the particular sections referenced by the examiner, plainly and unambiguously reinforces that the "busy case" disclosed in Hummelgren is the opposite case from that claimed by Applicant. Indeed, an electronic search of Hummelgren's issued patent identifies twenty-eight instances of the word "busy." Applicant has carefully reviewed each such instance, including those instances that

cover the examiner's specific citations, and confirmed that each instance is explicitly identified by Hummelgren as relating to the case where a mobile station is busy in circuit-switched call when a packet-switched call is received. See, for example, Hummelgren's "Brief Description of the Drawings," which identifies Fig. 3 as "a block diagram which conceptually illustrates how a GPMSC according to the present invention processes packet-switched voice calls directed to a mobile subscriber unit that is busy in a circuit-switched call." (Emphasis added.)

Further, see Hummelgren's "Background" at col. 1, lines 52-59, where it is stated that:

It is desirable in view of the foregoing to process incoming packet-switched voice calls such that the voice packets are not rejected if the mobile subscriber unit to which they are directed is busy in a circuit-switched call. According to the present invention, packet-switched voice calls directed to a mobile subscriber unit that is busy in a circuit-switched call are accommodated without rejecting the voice packets.

(Emphasis added.)

Thus, Applicant asserts that Hummelgren expressly teaches the case where an incoming packet-switched call is received for a mobile station that is busy in a circuit-switched call, where claim 1 (and the other claims rejected as anticipated) expressly are directed to the opposite case where an incoming (circuit-switched) voice call is received for a mobile station that is busy in a packet-switched data call. (Paragraph [0017] and many other sections of Applicant's specification clarify that the claimed voice call is a circuit-switched call.)

Hummelgren does not teach receiving an incoming circuit-switched call for a mobile station busy in a packet-switched data call, and the anticipation rejections fail as a matter of law for that reason alone. Moreover, lacking such teachings, Hummelgren by definition does not teach the additional claim 1 limitations of "sending an incoming call notification to the mobile station via signaling over an existing traffic channel allocated to the data call," and, "reconfiguring the existing traffic channel to support the incoming voice call and delivering the incoming voice call to the mobile station via the reconfigured existing traffic channel."

Those skilled in the art will understand that those limitations claim using a packet-switched traffic channel to deliver notification of an incoming circuit-switched voice call, and reconfiguration of that packet-switched traffic channel to support connection of the circuit-switched voice call to the mobile station. The specification explains several advantages of this reconfiguration approach in comparison to a complete tear-down and new channel establishment approach.

Because Hummelgren does not teach processing for the case where an incoming circuit-switched voice call is received for a mobile station busy in a packet-switched data call, it plainly cannot and does not teach the claimed reconfiguring of a packet-switched traffic channel for delivery of a circuit-switched voice call. The examiner's rejection arguments assert that Hummelgren does provide exactly those teachings, and refers to Hummelgren's Figs. 6-10 and their descriptions for support. Rather than support that rejection, those figures and their corresponding descriptions contradict the rejection.

For example, Hummelgren's drawing descriptions state that Fig. 6 "illustrates one exemplary response of the GPMS when the mobile subscriber unit is busy in FIG. 4 or does not accept the call in FIG. 5." From Hummelgren's description of Fig. 4 and the related description of Fig. 3, "busy" in Fig. 4 explicitly means the case where an incoming packet-switched call is received for a mobile station busy in a circuit-switched call.

Further, with reference to Fig. 5, Hummelgren at col. 3, lines 1-5, explicitly state that Hummelgren's call waiting features "provide at the mobile subscriber unit a unique indication (e.g. audible) that enables the user to determine that the waiting call is a packet-switched voice call." That is done in the case that the mobile station has an existing circuit-switched call active, and explicitly is not the claimed limitation in claim 1 of "sending an incoming call notification to the mobile station via signaling over an existing traffic channel allocated to the data call."

Still further, col. 3, lines 24-33 of Hummelgren explain that the processing of Fig. 6 applies to an incoming packet-switched voice call in the case where a mobile station is busy in a circuit-switched call or in the case where the mobile station user chooses not to accept the incoming packet-switched call. In either case, Fig. 6 teaches routing the IP packets of that incoming call to a voice mailbox. Col. 4, lines 1-3 of Hummelgren state that such operation should be understood as teaching that Hummelgren's GPMSC operates as a proxy server by rerouting the packet-switched voice call in the above described manner. That teaching expressly is not the claimed reconfiguring of a mobile station's packet-switched traffic channel for delivery of a circuit-switched voice call.

Hummelgren's description of Fig. 7 identifies similar proxy operations, and offers nothing relevant to the claimed limitations. Hummelgren's description of Fig. 8 identifies a different approach, where the incoming packet-switched voice call is converted to circuit-switched signals. However, that circuit-switched conversion is not routed to the mobile station but rather routed to a circuit-switched voice mailbox associated with the mobile station. (Even if the converted call was routed to the mobile station—it is not—that action would not match Applicant's carefully claimed limitations.)

Hummelgren's description of Fig. 9 identifies that Hummelgren's GPMSC also can set up a circuit-switched connection to a conventional telephone number (i.e., not the mobile station) in response to an incoming packet-switched voice call received for a mobile station busy in a circuit-switched voice call. That contrasts with Fig. 8 in that a circuit-switched conversion of the packet-switched voice call is routed to an alternate phone number rather than to a voice mailbox. No matter, because in either case, Hummelgren's teachings have nothing to do with the claim limitations at issue.

Similarly, Hummelgren's description of Fig. 10 addresses the case where a mobile station busy in a circuit-switched voice call chooses to accept an incoming packet-switched

voice call. In that case, Hummelgren's GPMS establishes an IP link with the Internet host the packet-switched call originates from, and sets up a corresponding circuit-switched connection to the mobile station. Hummelgren expressly states that it "sets up" a circuit-switched connection for that purpose. It does not state or suggest that it takes a packet-switched connection and reconfigure it for circuit-switched use.

Bluntly, the anticipation rejection of claim 1 is wholly unsupported and fails as a matter of law. Applicant will set forth the above arguments on appeal, should the examiner persist in this improper rejection. Claims 6, 8, and 9 depend from claim 1. The anticipation rejection of those claims fails for at least the same reasons.

Independent claim 10 is directed to a method at a base station, and claims receiving an incoming (circuit-switched) voice call indication at a base station that is targeted to a mobile station busy in a packet-switched voice data call. Claim 10 further explicitly claims "sending a call notification message to the mobile station and, responsive to receiving a return acknowledgment from the mobile station, reconfiguring the service connection of the mobile station to deliver the incoming voice call using the existing traffic channel."

As detailed for claim 1, Hummelgren does not teach or suggest the scenario explicitly claimed in claim 10, and by definition does not teach or suggest the processing explicitly claimed in claim 10. The anticipation rejection of claim 10, and its dependent claims 13, 15, and 16, therefore fails as a matter of law.

Independent claim 17 is an apparatus claim corresponding to independent method claim 10. Thus, for at least the reasons given for claims 1 and 10, the anticipation rejection of claim 17, and its dependent claims 19, 20, 22, and 23, fails as a matter of law.

Independent claim 27 is a method claim corresponding to operations at a mobile station, where those operations complement the base station operations claimed in independent claim 17, for example.



Applicant herein amends claim 27 to clarify that the claim limitations involve circuit-switched voice calls and packet-switched data calls. Claim 27 is further amended to incorporate all of the limitations of dependent 29, which is canceled by amendments herein. These changes comport with the foregoing arguments and clarify the claims' patentable distinctions over Hummelgren.

The examiner's rejection arguments provide no discussion of claims 27 and 29. However, claim 27 claims mobile-side operations for the case where an incoming circuit-switched voice call is received for a mobile station that is busy in a packet switched data call, wherein the mobile station renegotiates the traffic channel being used by it for the packet-switched data call, for use in connecting the circuit-switched voice call. Hummelgren is devoid of those teachings, and Applicant submits that claim 27 is in condition for immediate allowance.

More broadly, in view of the amendments and arguments made herein, Applicant submits that the instant application stands in condition for immediate allowance over Hummelgren (which is commonly owned with the instant application). The undersigned attorney would welcome the opportunity to discuss by telephone any issues not resolved to the examiner's satisfaction.

Respectfully submitted,

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